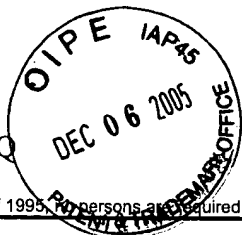


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.0979-00

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on _____

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Typed or printed
name _____

Application Number

10/024,353

Filed

12/21/2001

First Named Inventor

Daniela GIACCHETTI

Art Unit

3737

Examiner

Smith, Ruth S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 53,056
Signature

Frank A. Italiano

Typed or printed name

202-408-4460

Telephone number

December 6, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Customer No. 22,852
Attorney Docket No. 05725.0979-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Daniela GIACCHETTI et al.) Group Art Unit: 3737
)
Application No.: 10/024,353) Examiner: Smith, Ruth S.
)
Filed: December 21, 2001)
)
For: SIMULATION OF AN AESTHETIC) Confirmation No.: 4662
FEATURE ON A FACIAL IMAGE)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the final Office Action mailed June 6, 2005 ("Final Office Action"). This Request, accompanied by a completed form PTO/SB/33, is being filed concurrently with a Notice of Appeal under 37 C.F.R. § 41.31 and prior to the filing of an Appeal Brief, in accordance with the Official Gazette Notice of July 12, 2005.

Section 102(b) rejection

In the Final Office Action, claims 33 and 58 were rejected under 35 U.S.C. § 102(b) as anticipated by *Apple Corps*. That rejection is based on clear legal and factual errors.

First, the Examiner has not established that *Apple Corps* qualifies as prior art under § 102(b). The *Apple Corps* document appears to be an Internet printout. To apply *Apple Corps* as a "printed publication" within the meaning of § 102, the Examiner must produce "a satisfactory showing that such document has been disseminated or otherwise made available to

the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” M.P.E.P. § 2128 (internal citations omitted). Further, Applicants note that an electronic publication cannot be relied upon as prior art if it does not include a publication date or retrieval date. *See* M.P.E.P. § 2128. In this case, the Examiner indicated a date of 1999 on the form PTO-892 accompanying the Office Action of June 17, 2003. However, the Examiner has not indicated the origin of the 1999 date and has not established that the 1999 date is relevant to the document’s availability, publication, or retrieval. *Apple Corp* thus should not be used to reject Applicants’ claims. *See* M.P.E.P. § 2128.

Second, the Examiner has not complied with M.P.E.P. § 608.01(n)(III), which states that a “dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim” and “[i]t is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.” The Examiner must compare claims 1 and 33 with the prior art as if they were presented as one independent claim. Similarly, the Examiner must compare claims 34 and 58 with the prior art as if they were presented as one independent claim. The Examiner, however, has not compared the claims and the cited art in accordance with M.P.E.P. § 608.01(n)(III). *See* Final Office Action at 2, 4.

Third, *Apple Corps* does not teach each and every feature of claim 33 or 58. *Apple Corps* does not teach each and every feature of claim 1 or claim 34. Indeed, claims 1 and 34 are not rejected in view of *Apple Corps*. Because *Apple Corps* fails to anticipate claims 1 and 34, the reference cannot anticipate dependent claims 33 and 58, which include all of the features of claims 1 and 34, respectively. Further, even if *Apple Corps* were construed as disclosing a processor capable of performing a method, the reference does not disclose that the processor is configured to perform either the method recited in claim 1 or the method recited in claim 34.

The Examiner provides no evidence, beyond conjecture, showing that *Apple Corps*'s alleged processor is "capable of performing the method." See Final Office Action at 2. For at least the above reasons and the reasons discussed at pages 2-4 of the Reply to Office Action filed March 21, 2005 ("Reply"), the § 102(b) rejection of claims 33 and 58 should be withdrawn.

Section 103(a) rejections

In the Final Office Action, claims 1-8, 10, 17, 20, 23-27, 29, 31-41, 43, 48, 51, and 53-58 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,571,003 ("*Hillebrand*"); claims 1-58 were rejected under § 103(a) as unpatentable over U.S. Patent No. 6,283,858 to ("*Hayes*"); and claims 1-32 and 34-57 were rejected under § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0064302 ("*Massengill*"). Each of these rejections is legally and factually deficient because *prima facie* obviousness has not been established, as discussed below.

A case for *prima facie* obviousness has not been established with respect to claims 1-8, 10, 17, 20, 23-27, 29, 31-41, 43, 48, 51, and 53-58 based on *Hillebrand*. The reference fails to teach or suggest the "simulated facial image" features of the claims (as affirmed by the Examiner) and nothing in the record supports a motivation to modify the reference in a manner resulting in Applicants' claimed combination. See Final Office Action at 2, 4; see also Reply at 4-9. The Examiner's allegations pertaining to motivation are completely conjectural.

As to the § 103(a) rejection of claims 1-58 based on *Hayes*, the Examiner again failed to establish *prima facie* obviousness. *Hayes* fails to teach or suggest certain features of the claims (as affirmed by the Examiner) and nothing in the record supports a motivation to modify the reference in a manner resulting in Applicants' claimed combination. See Final Office Action at 3-4; see also Reply at 9-12.

Additionally, *prima facie* obviousness has not been established with respect to claims 1-32 and 34-57 based on *Massengill*. This reference fails to teach or suggest certain features of the claims (as affirmed by the Examiner) and a properly supported motivation to modify the reference in a manner resulting in Applicants' claimed combination is lacking. *See* Final Office Action at 3-4; *see also* Reply at 12-15.

According to the Federal Circuit, "virtually all [inventions] are combinations of old elements." *See e.g., In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). An examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *Id.* The court explained that "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Id.*

Furthermore, the desire to combine or modify references must be proved with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Also, the evidence of a motivation or suggestion to modify a reference must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In this case, the Examiner merely provided descriptions of how the cited references allegedly teach certain features and how certain features were allegedly well known, without providing clear and particular reasons, supported by evidence, showing why a skilled artisan would modify the references as alleged. The Examiner's conjectural allegations regarding motivation are not supported by evidence on the record.

Applicants further note that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02. Here, even if “simulated facial images” were obvious or well known, as alleged by the Examiner, the Final Office Action failed to establish that any of claims 1-58, taken as a whole, would have been obvious in view of the applied art.

Applicants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together alleged disclosures of the cited references with other allegedly well known features. Such picking and choosing among isolated disclosures amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For at least the reasons explained above, and as further explained in Applicants’ Reply at pages 4-15, *prima facie* obviousness has not been established with respect to claims 1-58. As such, the § 103(a) rejections of claims 1-58 should be withdrawn.


Applicants request withdrawal of the outstanding rejections and the timely allowance of pending claims 1-58.

Please grant any extensions of time required to enter this request and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 6, 2005

By: 
Frank A. Italiano
Reg. No. 53,056